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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

CALATAYUD et al.

Serial No.: 08/278,112

Filed: July 20, 1994

For: ESTERS PREPARATION FOR THEIR PREPARATION
COMPOSITION AND METHODS FOR THE TREATMENT
OF INFLAMMATORY CONDITIONS

Group Art Unit: 1202

Examiner: M. Grumbling

3/3/95
#3
3/16/95

INFORMATION DISCLOSURE STATEMENT

Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231

February 28, 1995

Sir:

As a means of complying with the duty of disclosure under 37 CFR §1.56, and in accordance with 37 CFR §§1.97 and 1.98, Applicants, through the undersigned attorney, submit this Information Disclosure Statement. The patents, publications or other information submitted herewith are listed on the attached Form PTO-1449 and copies are attached.

In accordance with 37 CFR §1.97(c), this Information Disclosure Statement is being filed after the period set forth in 37 CFR §1.97(b), but before the mailing date of either a Final Action under 37 CFR §1.113 or Notice of Allowance under 37 CFR §1.311. A check including the amount of \$210.00 for the fee set forth in 37 CFR §1.17(p) is attached. Should any additional fee be required by the filing of this statement, please charge such fee to Deposit Account No. 06-1358. A duplicate copy of this paper is enclosed.

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Notwithstanding the foregoing, and for the following reasons, Applicants respectfully request that the noted fee be waived in the instant case. The instantly-cited documents were cited in the Austrian Examiner's Report with regard to a corresponding application in that country. That report (copy herewith) was received by the principle party in interest on July 11, 1994. Since all of the cited patent numbers were not known to the principal party and interest, that party doubted whether the numbers had been correctly cited by the Examiner and wrote to their Austrian patent agents on July 19, 1994, in that regard. The Austrian patent agents (in a letter of September 8, 1994) advised the principal party in interest that the Austrian Examiner was not prepared to compare the patent numbers cited by him with earlier Search Reports. The patent agents recommended ordering the cited patents and to deal with them. The five cited patent specifications were thus ordered on September 15, 1994.

Although the principal party in interest had received the patent copies by October 4, 1994, they had not had an opportunity to review them adequately to establish their relevance prior to the issuance of Paper No. 28 on October 13, 1994.

Thus, even though the documents were cited by a foreign Patent Office more than three months before the issuance of the first Office Action, the actual documents were not even in the hands of the principle party in interest less than a month prior to the issuance of the first Office Action in this case.

Under such circumstances Applicants submit that there was no lack of diligence on their part and that the accompanying remittance should be credited to the above-identified Deposit Account.

Relevance of the instantly-cited documents is considered to be as follows:

USP 3,928,326

See columns 12 and 13: Z is "esterified hydroxyl ... esterified with ... lower-alkanoic acids" (e.g. acetic acid, cf. claim 10) and R is "selected from alkyl groups with straight or branched hydrocarbon chains having 1-10 carbon atoms".

USP 4,695,625

See column 5: X = -OCOR (with R = C₁-C₁₂ alkyl) and R₁ = C₁-C₁₂ alkyl.

USP 4,925,933

See column 8: R₁ = C₁-C₁₂ straight chain or branched alkyl, R₂ = hydrogen, R₃ = -COR and R = C₁-C₁₂ straight chain or branched alkyl.

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GB-PS 916,996

Overlap occurs since P and Q can have the meaning "hydrogen", "lower alkyl", "monocyclic cycloalkyl" and "monocyclic aryl" (i.e. there is a complete overlap with the meanings for R₁ in the above application). However, this overlap only exists when X₂ in the above application has the meaning "fluorine" (since Y¹ in GB-PS 916,996 must be halogen, preferably fluoro).

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The scope of this Offenlegungsschrift is, on principle, identical with the scope of USP 3,928,326.

Respectfully submitted,
JACOBSON, PRICE, HOLMAN & STERN

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